UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/602,419	06/24/2003	Andrew R. Ferlitsch	SLA1329	9609

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EXAMINER
PHAM, THIERRY L

ART UNIT	PAPER NUMBER
2625	

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	04/27/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

PTOL-90A (Rev. 10/06)

	Application No.	Applicant(s)
	10/602,419	FERLITSCH, ANDREW R.
Office Action Summary	Examiner	Art Unit	
	Thierry L. Pham	2625	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *24 June 2003*.

2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-30* is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-30* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☒ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *29 September 2003* is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All   b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date *10/16/03*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

● This action is responsive to the following communication: Nonprovisional application filed on 6/24/03.

● Claims 1-30 are pending.

● IDS filed on 10/16/03 has been considered and herein attached (PTO 1449) with Office Action.

Specification

The disclosure is objected to because of the following informalities: ***Brief Summary of the Invention*** is missing from the specification. Appropriate correction is required.

Content of Specification

The following guidelines illustrate the preferred layout for the specification of a utility application. These guidelines are suggested for the applicant's use.

(a)   Title of the Invention: See 37 CFR 1.72(a) and MPEP § 606. The title of the invention should be placed at the top of the first page of the specification unless the title is provided in an application data sheet. The title of the invention should be brief but technically accurate and descriptive, preferably from two to seven words may not contain more than 500 characters.

(b)   Cross-References to Related Applications: See 37 CFR 1.78 and MPEP § 201.11.

(c)   Statement Regarding Federally Sponsored Research and Development: See MPEP § 310.

(d)   The Names Of The Parties To A Joint Research Agreement: See 37 CFR 1.71(g).

(e)   Incorporation-By-Reference Of Material Submitted On a Compact Disc: The specification is required to include an incorporation-by-reference of electronic documents that are to become part of the permanent United States Patent and Trademark Office records in the file of a patent application. See 37 CFR 1.52(e) and MPEP § 608.05. Computer program listings (37 CFR 1.96(c)), "Sequence Listings" (37 CFR 1.821(c)), and tables having more than 50 pages of text were permitted as electronic documents on compact discs beginning on September 8, 2000.

(f)   Background of the Invention: See MPEP § 608.01(c). The specification should set forth the Background of the Invention in two parts:

(1)   <u>Field of the Invention</u>: A statement of the field of art to which the invention pertains. This statement may include a paraphrasing of the applicable U.S. patent classification definitions of the subject matter of the claimed invention. This item may also be titled "Technical Field."

(2)   <u>Description of the Related Art including information disclosed under 37 CFR 1.97 and 37 CFR 1.98</u>: A description of the related art known to the applicant and including, if applicable, references to specific related art and problems involved in the prior art which are solved by the applicant's invention. This item may also be titled "Background Art."

(g)   <u>Brief Summary of the Invention</u>: See MPEP § 608.01(d). A brief summary or general statement of the invention as set forth in 37 CFR 1.73. The summary is separate and distinct from the abstract and is directed toward the invention rather than the disclosure as a whole. The summary may point out the advantages of the invention or how it solves problems previously existent in the prior art (and preferably indicated in the Background of the Invention). In chemical cases it should point out in general terms the utility of the invention. If possible, the nature and gist of the invention or the inventive concept should be set forth. Objects of the invention should be treated briefly and only to the extent that they contribute to an understanding of the invention.

(h)   <u>Brief Description of the Several Views of the Drawing(s)</u>: See MPEP § 608.01(f). A reference to and brief description of the drawing(s) as set forth in 37 CFR 1.74.

(i)   <u>Detailed Description of the Invention</u>: See MPEP § 608.01(g). A description of the preferred embodiment(s) of the invention as required in 37 CFR 1.71. The description should be as short and specific as is necessary to describe the invention adequately and accurately. Where elements or groups of elements, compounds, and processes, which are conventional and generally widely known in the field of the invention described and their exact nature or type is not necessary for an understanding and use of the invention by a person skilled in the art, they should not be described in detail. However, where particularly complicated subject matter is involved or where the elements, compounds, or processes may not be commonly or widely known in the field, the specification should refer to another patent or readily available publication which adequately describes the subject matter.

(j)   <u>Claim or Claims</u>: See 37 CFR 1.75 and MPEP § 608.01(m). The claim or claims must commence on separate sheet or electronic page (37 CFR 1.52(b)(3)). Where a claim sets forth a plurality of elements or steps, each element or step of the claim should be separated by a line indentation. There may be plural indentations to further segregate subcombinations or related steps. See 37 CFR 1.75 and MPEP § 608.01(i)-(p).

(k)   Abstract of the Disclosure: See MPEP § 608.01(f). A brief narrative of the
        disclosure as a whole in a single paragraph of 150 words or less commencing on a
        separate sheet following the claims. In an international application which has
        entered the national stage (37 CFR 1.491(b)), the applicant need not submit an
        abstract commencing on a separate sheet if an abstract was published with the
        international application under PCT Article 21. The abstract that appears on the
        cover page of the pamphlet published by the International Bureau (IB) of the
        World Intellectual Property Organization (WIPO) is the abstract that will be used
        by the USPTO. See MPEP § 1893.03(e).

(l)   Sequence Listing, See 37 CFR 1.821-1.825 and MPEP §§ 2421-2431. The
        requirement for a sequence listing applies to all sequences disclosed in a given
        application, whether the sequences are claimed or not. See MPEP § 2421.02.

Claim Rejections - 35 USC § 101

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter or any new

and useful improvement thereof, may obtain a patent therefore, subject to the conditions and requirements of this title.

Claim 16 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-
statutory subject matter.

> The claimed invention is a computer related invention. The Computer-Implemented Invention Guidelines issued
> by the U.S. Patent and Trademark Office describe the procedures for examining such inventions.

The first step is to determine whether the invention as defined by the claims falls within one of
the three following categories of unpatentable subject matter: (1) Functional descriptive material
such as a data structure *per se* or a computer program *per se*, (2) Non-functional descriptive
material such as music, literary works or pure data, embodied on a computer readable medium;
or (3) A natural phenomenon such as energy or magnetism. The invention as defined by the
claims is not a natural phenomenon or pure data, however, it is a computer program per se,
which does not mount/store on any computer-readable medium; therefore, these claims are
rejected for non-statutory basis.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 23-25 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The original filed specification does not provide an adequate written description of an imaging server comprising: (1) computer device and (2) imaging device. According to the original filed specification, imaging server, computer device, and an imaging device are all separate device rather than as a single device as claimed in claim 23. Clarification is herein required.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 23-25 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The examiner is unclear whether the applicant is claiming an imaging system or an imaging server, since the imaging server alone does not contain a computer device and an imaging device (see 112, 1st paragraph above for details). Therefore, the examiner herein assumes "an imaging system" is herein being claimed rather than "imaging server" as cited in claims 23-25. If the applicant is claiming an imaging server, then clarifications and/or appropriate actions are herein required.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1, 3-4, 6, 8-16, 18-27 are rejected under 35 U.S.C. 102(a) and/or 102(e) as being anticipated by Tanaka et al (US 6519048).

Regarding claim 1, Tanaka discloses a method for monitoring (monitoring a print job, fig. 5-7) an imaging job sent to an imaging device (network printer, fig. 1 & 7) being used by a computer system (host computer, fig. 1 & 7), the method comprising:

• sending (sending via network 109, fig. 1 & 7) an imaging job to an imaging device (network printer, fig. 1 & 7);

• receiving (receiving by network printer, fig. 1 & 7) the imaging job at the imaging device;

• discovering (address extracting means for extracting network address of host computer that has been embedded in the print job, col. 5, lines 30-35) an implicit network address from the imaging job;

• starting (staring processing the print job by network printer, fig. 7) the imaging job at the imaging device; and

• sending (sending via network 109, fig. 1 & 7) a status message (status message, fig. 7, col. 5, lines 35-40) for the imaging job to the network address.

Regarding claim 3, Tanaka further discloses the method of claim 1, further comprising receiving the status message by (fig. 7) a client computing device.

Regarding claim 4, Tanaka further discloses the method of claim 3, further comprising verifying that the imaging job of the status message originated (fig. 7, col. 6, lines 1-20) on the client computing device.

Regarding claim 6, Tanaka further discloses the method of claim 1, further comprising registering (fig. 7) a client computing device with an imaging server (printer server, fig. 7) to receive notifications regarding the imaging job.

Regarding claim 8, Tanaka further discloses the method of claim 6, further comprising sending the imaging job from the client computing device to the imaging server (print server, col. 4, lines 1-5) before the imaging job is sent to the imaging device.

Regarding claim 9, Tanaka further discloses the method of claim 8, further comprising receiving the status message by the imaging server and sending the status message from (from printer server to client computer, fig. 7) the imaging server to the client computing device.

Regarding claim 10, Tanaka further discloses the method of claim 9, further comprising verifying (verification process as shown in fig. 7) that the imaging job of the status message originated on the client computing device.

Regarding claim 11, Tanaka further discloses the method of claim 9, further comprising verifying (verification process as shown in fig. 7)that the imaging job of the status message was communicated through the imaging server.

Regarding claim 13, Tanaka further discloses the method of claim 8, further comprising receiving the status message by the imaging server and sending the status message from the imaging server to a monitor (cols. 5-6) on the client computing device.

Regarding claim 14, Tanaka further discloses the method of claim 8, further comprising receiving the status message by a server monitor on the imaging server and sending the status message from the server monitor on the imaging server to a monitor (status message for user to view, cols. 5-6) on the client computing device.

Regarding claim 15, Tanaka further discloses the method of claim 6, wherein registering (register IP address of client computer, fig. 7, cols. 5-6)the client computing device with the imaging server includes providing a client computing device address to the imaging server.

Regarding claim 16 recites limitations that are similar and in the same scope of invention as to those in claim 1 above; therefore, claim 16 is rejected for the same rejection rationale/basis as described in claim 1.

Regarding claims 18-22, Tanaka further discloses a computer-readable medium (e.g. RAM or ROM, fig. 4) that is part of printer, scanner, fax, print server, and etc.

Regarding claim 23, Tanaka further discloses an imaging server (printing system, fig. 1 & 7) configured to implement a method for monitoring (monitoring a print job, fig. 5-7) an imaging job for use with an imaging device that utilizes implicit network address discovery, the imaging server comprising:

● a computing device (host computer, fig. 7);

● an imaging device (network printer, fig. 7)in electronic communication with the computing device;

● executable instructions (instructions as shown in fig. 5-7) executable on the computing device, wherein the executable instructions are configured to implement a method comprising:

● allowing a client computing device to register with the imaging server to receive notifications regarding an imaging job;

● receiving the imaging job (fig. 7) from the client computing device;

● sending (sending via network 109, fig. 1 & 7) the imaging job to the imaging device, wherein the imaging device discovers (address extracting means for extracting network address of host computer that has been embedded in the print job, col. 5, lines 30-35) an implicit network address from the imaging job and sends a status message for the imaging job to the network address, and wherein the discovering of the implicit network address is achieved without using an explicit address in the imaging job;

● receiving (receiving by network printer, fig. 1 & 7) a status message from the imaging device relating to the imaging job;

● using registration (address of client computer, fig. 7, cols. 5-6)information to identify the client computing device; and

• sending the status message (status message, fig. 7, col. 5, lines 35-40) to the client computing device.

Regarding claim 24, Tanaka further discloses the imaging server of claim 23, further comprising a server monitor for receiving the status message on the imaging server and for sending the status message from the server monitor on the imaging server to a monitor (status message to be displayed on user's monitor, fig. 7, cols. 5-6) on the client computing device.

Regarding claim 25, Tanaka further discloses thee imaging server of claim 24, wherein the registration information includes a client computing device address (device ID, cols. 5-6).

Regarding claim 26, Tanaka further discloses a system (printing system, fig. 1 & 7)for monitoring an imaging job and for implicit network address discovery (address extracting means for extracting network address of host computer that has been embedded in the print job, col. 5, lines 30-35), the system comprising: a computing device (fig. 1 & 7); an imaging device (printer, fig. 1 & 7) in electronic communication with the computing device; executable instructions (instructions, fig. 5-7) executable on the imaging device, wherein the executable instructions are configured to implement a method comprising: receiving (receiving, fig. 7) the imaging job at the imaging device; discovering (address extracting means for extracting network address of host computer that has been embedded in the print job, col. 5, lines 30-35) an implicit network address from the imaging job without using an explicit address embedded in the imaging job; starting (printing process, fig. 7) the imaging job at the imaging device; and sending a status message (status message from printer to client, fig. 7, cols. 5-6) for the imaging job to the network address.

Regarding claim 27, Tanaka further discloses the system of claim 26, further comprising an imaging server in electronic communication with the computing device and the imaging device, wherein the imaging job is sent from the computing device to (from client to printer server, fig. 7) the imaging server, and wherein the imaging server sends the imaging job to the imaging device (then from printer server to printer, fig. 7, cols. 5-6).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 2, 5, 7, 12, 17, 28-30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tanaka as described in claims 1, 16, and 26 above, and in view of Leiman et al (US 6469796).

Regarding claims 2 & 28, Tanaka fails to teach and/or suggest discovering the implicit network address is achieved without using an explicit process of a monitoring process in the imaging job.

Leiman, in the same field of endeavor for monitoring print job status, teaches a well-known example of discovering the implicit network address is achieved without using an explicit process of a monitoring process in the imaging job.

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify obtaining method for network address as taught by Tanaka to include a well-known example of discovering the implicit network address is achieved without (print server detects IP address of each devices in a network without having to embedded in it the print job, figs. 5-31) using an explicit process of a monitoring process in the imaging job as taught by Leiman because of a following reason: (●) allowing multiple users to view print job status of others including his/her own by registering network address with printer's server (open printing system as shown in figs. 1-3).

Therefore, it would have been obvious to combine Tanaka with Leiman to obtain the invention as specified in claims 2 & 28.

Regarding claims 5, 7 & 17, Leiman further teaches imaging device is selected from the group consisting of a printer, a scanner, a fax machine, a copier and a document server (selecting a device for processing a print job is well known and widely available use in the art, fig. 5).

Regarding claims 12, 29-30, Leiman further teaches an example of receiving the status message by a monitor (fig. 15) on a client computing device or printer's server monitor.
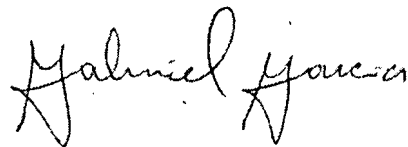
Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thierry L. Pham whose telephone number is (571) 272-7439. The examiner can normally be reached on M-F (9:30 AM - 6:00 PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David K. Moore can be reached on (571)272-7437. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Thierry L. Pham

GABRIEL I. GARCIA
PRIMARY EXAMINER